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4 RESEARCH DRIVE
SHELTON, CT 06484-6212

EXAMINER
PEREZ, ANGELICA

ART UNIT	PAPER NUMBER
2618	

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Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No.	Applicant(s)	
	10/748,873	CHIPCHASE, JAN	
	Examiner	Art Unit	
	Perez M. Angelica	2618	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *13 June 2007*.

2a)☐ This action is **FINAL**. 2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1,3-17 and 22-43* is/are pending in the application.

4a) Of the above claim(s) *44 and 45* is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1,3-17 and 22-43* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☒ Information Disclosure Statement(s) (PTO/SB/08) Paper No(s)/Mail Date 6/13/07
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____.
5) ☐ Notice of Informal Patent Application
6) ☐ Other: _____.

DETAILED ACTION

Response to Arguments

1. Applicant's arguments, see amendment, filed 6/13/2007, with respect to the rejection(s) of claim(s) under Claim Rejections - 35 USC § 102 (e) have been fully considered and are persuasive. Therefore, the rejection has been withdrawn. However, upon further consideration, a new ground(s) of rejection is made in view of Silverbrook and Schultheis.

Claim Rejections - 35 USC § 112

2. The following is a quotation of the second paragraph of 35 U.S.C. 112:

> The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

3. Claim 43 is rejected under 35 U.S.C. 112, second paragraph.

Claim 43 recites the limitation "the metadata" in line 2. There is insufficient antecedent basis for this limitation in the claim. Is the metadata same as computer readable instructions?

Claim Rejections - 35 USC § 101

4. 35 U.S.C. 101 reads as follows:

> Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

5. Claim 43 is rejected under 35 U.S.C. 101 because the claimed invention is not supported by either an asserted utility or a well established utility.

There is no functional relationship between the printed matter and the electronic device. There is no indication where the computer readable instructions are

executed/compiled/run, etc. by the device. Since there is nothing in the claim that indicates that the instructions actually read and cause an operation to be performed, the limitation can be simply read as instructions that are readABLE and are "for" an operation (probably just a simple "to do" list handwritten on a piece of paper telling a user to do certain steps on the computer). In addition, the examiner would like to point out where the claim was amended, although, it is labeled as original.

Claim 43 is also rejected under 35 U.S.C. 112, first paragraph. Specifically, since the claimed invention is not supported by either a asserted utility or a well established utility for the reasons set forth above, one skilled in the art clearly would not know how to use the claimed invention.

Claim Rejections - 35 USC § 102

4. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

> A person shall be entitled to a patent unless –
>
> (e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

The changes made to 35 U.S.C. 102(e) by the American Inventors Protection Act of 1999 (AIPA) and the Intellectual Property and High Technology Technical Amendments Act of 2002 do not apply when the reference is a U.S. patent resulting directly or indirectly from an international application filed before November 29, 2000. Therefore, the prior art date of the reference is determined under 35 U.S.C. 102(e) prior to the amendment by the AIPA (pre-AIPA 35 U.S.C. 102(e)).

5. Claim 43 is rejected under 35 U.S.C. 102(e) as being anticipated by Herzig et al. (Herzig, US Patent No.: 6,594,503 B1).

Regarding claim 43, Herzig teaches of a document bearing a printed image and incorporating machine-readable metadata associated with the image (column 3, lines 31-42, where the claim does not indicate when/how the additional data, metadata, is incorporated. In addition, there is no indication of where the printed image comes from, it can be printed image form a newspaper, book, handwriting, etc. Column 2, lines 14-40, where the printed image (e.g., a "name") is scaned and additional data, metadata, is added (e.g., "telephone number"), the metadata identifying an instruction for operation of an electronic device (column 2, lines 20-44, where the instruction is to dial a telephone, fax, number to make a call).

Claim Rejections - 35 USC § 103

6. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

7. Claims 1, 3-12, 14-17, 22-23, 26-37 and 40-42 are rejected under 35 U.S.C. 103(a) as being unpatentable over Herzig in view of Silverbrook, Kia (Silverbrook, US Pub. No.: 2002/0,140,993 A1) and further in view of Schultheis, Joerg-Peter (Schultheis, DE010158358351A1).

Regarding claim 1, Herzig teaches of an electronic device (figure 2) comprising: data reading means operable to read metadata carried by an image carrier which carries a printed image (column 2, lines 21-24, where paper images can be carried in a folder); interpretation means operable to interpret the metadata to identify an instruction for operation of the device (column 2, lines 14-17, where the instruction is to dial a number); and execution means operable to cause the device to execute an instruction identified by the interpretation means (column 5, lines 46-47, where the "code representation is sent to the network" to request a call set up); and image system comprising (column 2, lines 21-29, where a system can comprise several elements that perform a function(s)) image means operable to receive data representing an image (columns 2 and 4, lines 21-25 and 11-16, where OCR/camera receive data representing an image); metadata means operable to generate metadata able to be interpreted to identify an instruction for an electronic device (column 2, lines 14-40, where the image received is a "name" and the metadata is the additional data collected from a look-up table, "telephone number" and the instruction is to dial a number), and to associate the metadata with the image data (column 2, lines 14-40, where a "telephone number" is associated with a "name"), where the device is a hand portable electronic device (column 2, lines 11-13).

Herzig teaches of printing the image, however, it is done in a separate device. Therefore, Herzig does not specifically teach of comprising printer means operable to receive data representing an image, and associated metadata, and to generate a printed image.

In art concerning a handheld mobile telephone with integral printer, Silverbrook teaches of comprising printer means operable to receive data representing an image, and associated metadata, and to generate a printed image, which incorporates the metadata (paragraphs 4 and 44 and claim 16).

It would have been obvious to one of ordinary skill in the art at the time the invention was made to combine Herzig's printed data with Silverbrook's printer in order to obtain a hard copy of captured images.

Herzig and Silverbrook do not specifically teach where the printed image incorporates the metadata.

In related art concerning a digital photographic and scanner camera with internal bar code scanner that can acquire additional data in text form as well as the digital photographs optically acquired by the camera, Schultheis teaches where the printed image incorporates the metadata (Abstract, where the additional text data, metadata, is added to the image).

It would have been obvious to one of ordinary skill in the art at the time the invention was made to combine Herzig's and Silverbrook's combined scanner/printer with Schultheis's addition of text data in to image in order to obtain data related plus the photographs in a printed form.

Regarding claim 3, Herzig, Silverbrook and Schultheis teach all the limitations according to claim 1. Herzig further teaches where the device is a multi-function portable device (column 2, lines 29-33, where in addition, the telephone can do faxes, internet; thus, multi-function).

Regarding claims 4 and 31, Herzig, Silverbrook and Schultheis teach all the limitations according to claims 1 and 29, respectively. Herzig further teaches the device is operable as a cellular telephone (column 2, lines 12-14).

Regarding claim 5, Herzig, Silverbrook and Schultheis teach all the limitations according to claim 1. Herzig further teaches where the execution means is operable to cause the device to initiate communication in response to an identified instruction (column 2, lines 14-17, where the instruction is to dial a number that starts the communication).

Regarding claims 6 and 29, Herzig, Silverbrook and Schultheis teach all the limitations according to claims 1 and 28, respectively. Herzig further teaches where the interpretation means is operable, in use, to recover personal data from the metadata (column 2, lines 29-40; e.g., "name", "phone number" and "fax number").

Regarding claims 7 and 30, Herzig, Silverbrook and Schultheis teach all the limitations according to claims 6 and 29, respectively. Herzig further teaches where the personal data recovered by the interpretation means includes at least one of a name, telephone number and contact details (column 2, lines 29-40; e.g., "name", "phone number" and "fax number").

Regarding claims 8 and 28, Herzig, Silverbrook and Schultheis teach all the limitations according to claims 6 and 1, respectively. Herzig further teaches where the execution means is operable in response to an identified instruction to initiate communication with an individual identified by the personal data (column 2, lines 29-40;

e.g., "name", "phone number" and "fax number"; where the call is intending to initiate communication with the individual identified by name at least).

Regarding claim 9, Herzig, Silverbrook and Schultheis teach all the limitations according to claim 6. Herzig further teaches where the execution means is operable to add the personal data to the memory of the device, if not already contained there (column 2, lines 58-64; e.g., "memory 135").

Regarding claim 10, Herzig, Silverbrook and Schultheis teach all the limitations according to claim 1. Herzig further teaches where the data reading means is an optical device, which responds to metadata carried in visible form by the image carrier (column 2, lines 21-24).

Regarding claim 11, Herzig, Silverbrook and Schultheis teach all the limitations according to claim 10. Herzig further teaches where the visible metadata is carried in the form of a bar code (column 1, lines 31-34).

Regarding claim 12, Herzig, Silverbrook and Schultheis teach all the limitations according to claim 1. Herzig further teaches where the data reading means is a non-optical device operable to detect metadata carried in machine-readable form by the image carrier (column 1, lines 31-34; where, in addition, bar codes are read by infrared light).

Regarding claim 14, Herzig, Silverbrook and Schultheis teach all the limitations according to claim 1. Herzig further teaches where the interpretation means is operable to retrieve an instruction contained within the metadata (column 2, lines 14-17, where the instruction is to dial a number).

Regarding claim 15, Herzig, Silverbrook and Schultheis teach all the limitations according to claim 14. Herzig further teaches where the interpretation means interprets a retrieved instruction by reference to further stored interpretation data (column 2, lines 14-17, where the instruction is to dial a number (phone, fax, internet address, etc.) that has been retrieved from storage and where the software is programmed to automatically dial the retrieved number).

Regarding claim 16, Herzig, Silverbrook and Schultheis teach all the limitations according to claim 15. Herzig further teaches where the interpretation means is operable to receive metadata from the data reading means, in the form of an identifier, and uses the further stored interpretation data to recover an instruction identified by the identifier (column 2, lines 14-17, where the instruction is to dial a number (phone, fax, internet address, etc.) that has been retrieved from storage and where the software is programmed to automatically dial the retrieved number.

Regarding claim 17, Herzig, Silverbrook and Schultheis teach all the limitations according to claim 15. Herzig further teaches where the further stored interpretation data is stored remotely, the interpretation means being operable to communicate with the remote location to enable the interpretation means to use the further stored interpretation data (column 3, lines 20-27, "external character recognition processor").

Regarding claim 22, Herzig, Silverbrook and Schultheis teach all the limitations according to claim 1. Herzig further teaches where the metadata means is operable in response to a user input to generate metadata (column 3, lines 9-18, where the user's input is scanning the pictures, code, text, etc.).

Regarding claim 23, Herzig, Silverbrook and Schultheis teach all the limitations according to claim 1. Herzig further teaches where the metadata means is operable to retrieve stored data for incorporation into the metadata (column 3, lines 21-27, where the stored data can be a telephone number, address, etc.).

Regarding claim 26, Herzig, Silverbrook and Schultheis teach all the limitations according to claim 1. Herzig further teaches where the metadata means is operable to analyze a represented image to identify a subject therein, and to provide data representative of the subject, for incorporation into the metadata (column 2, lines 33-40, e.g., "name" corresponding to a subject).

Regarding claim 27, Herzig, Silverbrook and Schultheis teach all the limitations according to claim 1. Herzig further teaches where the metadata means is operable to perform a selection of stored data from a stored data set, the selection being performed in dependence on data to be incorporated into the metadata, to recover additional data for incorporation (column 3, lines 25-41).

Regarding claim 32, Herzig, Silverbrook and Schultheis teach all the limitations according to claim1.

Silverbrook teaches of comprising printer means operable to receive data representing an image, and associated metadata, and to generate a printed image, which incorporates the metadata (paragraphs 4 and 44 and claim 16).

It would have been obvious to one of ordinary skill in the art at the time the invention was made to combine Herzig's, Silverbrook's and Schultheis' printed data with

Silverbrook's further teachings about a printer in order to obtain a hard copy of captured images.

Schultheis further teaches where the printed image incorporates the metadata (Abstract, where the additional text data, metadata, is added to the image).

It would have been obvious to one of ordinary skill in the art at the time the invention was made to combine Herzig's, Silverbrook's and Schultheis' combined scanner/printer with Schultheis's addition of text data in to image in order to obtain data related, plus the photographs in a printed form.

Regarding claim 33, Herzig, Silverbrook and Schultheis teach all the limitations according to claim 32.

Schultheis further teaches where the metadata is incorporated within the image area of the printed image (abstract).

It would have been obvious to one of ordinary skill in the art at the time the invention was made to combine Herzig's and Silverbrook's combined scanner/printer with Schultheis's addition of text data in to image in order to obtain data related plus the photographs in a printed form.

Regarding claim 34, Herzig, Silverbrook and Schultheis teach all the limitations according to claim 33. Herzig further teaches where the metadata is incorporated in encoded form (column 1, lines 31-33; e.g., "bar code format").

Regarding claim 35, Herzig, Silverbrook and Schultheis teach all the limitations according to claim 32. Herzig further teaches where the metadata is incorporated in an optically readable form (column 2, lines 21-24).

Regarding claim 36, Herzig, Silverbrook and Schultheis teach all the limitations according to claim 35. Herzig further teaches where the metadata is incorporated in the form of a bar code (column 1, lines 31-33; e.g., "bar code format").

Regarding claim 37, Herzig, Silverbrook and Schultheis teach all the limitations according to claim 32. Herzig further teaches the metadata is incorporated in non-optical machine-readable form (column 1, lines 31-34; where, in addition, bar codes are read by infrared light).

Regarding claim 40, Herzig, Silverbrook and Schultheis teach all the limitations according to claim 32. Herzig further teaches the metadata contains the instruction (column 2, lines 29-40; where instruction is to initiate a call).

Regarding claim 41, Herzig, Silverbrook and Schultheis teach all the limitations according to claim 32. Herzig further teaches where the metadata contains sufficient information to identify the instruction by reference to further stored interpretation data (column 2, lines 29-40; where the further stored data is the phone number, internet address, fax number, etc.).

Regarding claim 42, Herzig, Silverbrook and Schultheis teach all the limitations according to claim 32. Herzig further teaches where the metadata includes an identifier usable to recover an instruction identified by the identifier (column 2, lines 26-30).

8. Claims 13 and 38 are rejected under 35 U.S.C. 103(a) as being unpatentable over Herzig in view of Silverbrook and Schultheis and further in view of Schlasberg, Johan (Schlasberg, WO 99/17230).

Regarding claim 13, Herzig, Silverbrook and Schultheis teach all the limitations according to claim 12.

Herzig, Silverbrook and Schultheis do not specifically teach where a radio frequency identification device provides the machine-readable metadata.

In related art concerning a message information system, Schlasberg teaches where the machine-readable metadata is provided by a radio frequency identification device (pages 3, 4,5, lines 7-16; lines 4-25 and 16-10, 30-34, respectively).

It would have been obvious to one of ordinary skill in the art at the time the invention was made to combine Herzig's, Silverbrook's and Schultheis' electronic device with Schlasberg's RFID reader in order to directly obtain information about objects without having to be so close to them, as taught by Schlasberg.

Regarding claim 38, Herzig, Silverbrook and Schultheis teach all the limitations according to claim 37.

Herzig, Silverbrook and Schultheis do not specifically teach where a radio frequency identification device provides the machine-readable metadata.

Schlasberg teaches where the machine-readable metadata is provided by a radio frequency identification device (pages 3, 4,5, lines 7-16; lines 4-25 and 16-10, 30-34, respectively).

It would have been obvious to one of ordinary skill in the art at the time the invention was made to combine Herzig's Silverbrook's and Schultheis's electronic device with Schlasberg's RFID reader in order to directly obtain information about objects without having to be so close to them, as taught by Schlasberg.

9. Claims 24-25 are rejected under 35 U.S.C. 103(a) as being unpatentable over Herzig in view of Silverbrook and Schultheis and further in view of Browning, Denton R. (Browning, US Patent No.: 6,707,581 B1).

Regarding claim 24, Herzig, Silverbrook and Schultheis teach all the limitations according to claim 1.

Herzig, Silverbrook and Schultheis do not specifically teach where the metadata means is operable to incorporate data representing the conditions in which the image has been captured.

In related art concerning a remote information access system, which utilizes handheld scanner, Browning teaches where the metadata means is operable to incorporate data representing the conditions in which the image has been captured (37-47, e.g., "poor").

It would have been obvious to one of ordinary skill in the art at the time the invention was made to combine Herzig's, Silverbrook's and Schultheis' electronic device with Browning's feedback about the condition of the scanned work in order to re-scan, as taught by Browning.

Regarding claim 25, Herzig, Silverbrook and Schultheis teach all the limitations according to claim 1.

Herzig, Silverbrook and Schultheis do not specifically teach where the metadata means is operable to incorporate at least one of time data, date data, location data and operating settings of data capture means used to capture the represented image.

Browning teaches where the metadata means is operable to incorporate at least one of time data, date data, location data and operating settings of data capture means used to capture the represented image (column 3, lines 51-57).

It would have been obvious to one of ordinary skill in the art at the time the invention was made to combine Herzig's, Silverbrook's and Schultheis' electronic device with Browning's "date and time" information in order to "facilitate later cataloguing and retrieval of scanned information", as taught by Browning.

10. Claim 39 is rejected under 35 U.S.C. 103(a) as being unpatentable over Herzig in view of Silverbrook and Schultheis and further in view of Wilcock et al. (Wilcock, US Patent No.: 6,741,864 B2).

Regarding claim 39, Herzig, Silverbrook and Schultheis teach all the limitations according to claim 32.

Herzig, Silverbrook and Schultheis do not specifically teach where the metadata is written to a member, which is initially separate from the image carrier on which the image is printed, and is attachable thereto.

In related art concerning a device control apparatus and method, Wilcock teaches where the metadata is written to a member which is initially separate from the image carrier on which the image is printed, and is attachable thereto (column 11, lines 1-12, where the metadata, e.g., location, is originally, in a label separate form the picture).

It would have been obvious to one of ordinary skill in the art at the time the invention was made to combine Herzig's, Silverbrook's, Schultheis's combination of the

device with Wilcock's labeling in order to "enable map-based cataloging of image recordings", as taught by Wilcock.

Conclusion

11. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Angelica Perez whose telephone number is 571-272-7885. The examiner can normally be reached on 6:00 a.m. - 1:30 p.m., Monday - Friday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Matthew D. Anderson can be reached on (571) 272-4177. The fax phone numbers for the organization where this application or proceeding is assigned are 571-273-8300 for regular communications and for After Final communications.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either the PAIR or Public PAIR. Status information for unpublished applications is available through the Private PAIR only. For more information about the pair system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). Information regarding Patent Application Information Retrieval (PAIR) system can be found at 866-217-9197 (toll-free).

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the TC 2600's customer service number is 703-306-0377.

Angelica Perez
Examiner

MATTHEW ANDERSON
SUPERVISORY PATENT EXAMINER

Art Unit 2618

September 18, 2007